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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,053	08/20/2001	Rolf Heinemann	SBV-07699	6719

7590

05/21/2003

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EXAMINER

FULLER, ERIC B

ART UNIT	PAPER NUMBER
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1762

8

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

# Office Action Summary

Application No.

09/933,053

Applicant(s)

HEINEMANN ET AL

Examiner

Eric B Fuller

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 – 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer et al. (US 5,080,056) in view of Sailer et al. (US 5,644,828) and Hammeke (US 4,724,299).

Kramer teaches alloying and coating the interior walls of cylinder bores with a wear resistant material (column 2, lines 12-16) by thermal spraying (column 2, lines 17-29). Kramer further teaches that the powder material used for coating/alloying is an aluminum/silicon alloy (column 4, line 7). The coating is deposited onto and alloyed into the substrate. The reference cited examples of plasma spraying and arc spraying as suitable forms of thermal spraying, but does not limit the invention to such. However, the reference fails to explicitly teach laser spraying as a suitable form of thermal spraying.

Sailer teaches that plasma spraying, arc spraying, and laser spraying are all equivalent forms of thermal spraying. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize laser spraying as the method of thermal spraying in Kramer with a reasonable expectation of

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success, as Sailer teaches equivalence. However, Sailer fails to teach how the method of laser spraying is performed.

Hammeke teaches a method of laser spraying wherein the coating powder is fed through a laser apparatus such that the apparatus may be used to coat complexly shaped substrates uniformly and quickly (column 5, lines 17-25). The powder is fed coaxially with the laser beam and is converged on a common focal point with the laser beam that creates a melt pool in the substrate (column 2, lines 15-20). One of ordinary skill would recognize that since the powder stream and laser are one elongated device, such an arrangement would be ideal for fitting into the small diameters bores of Kramer. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a laser spraying method such as that taught by Hammeke in order to form the alloy/coating of Kramer. By doing so, one would have a reasonable expectation of success, as Sailer teaches the equivalence of laser spraying with other forms of thermal spraying. Modifications to the apparatus of Hammeke so that the inner wall of a cylinder is coated as opposed to an area directly below the nozzle, such as deflecting the laser beam and powder streams towards the wall, are all within the skill of one practicing in the art when taken in view of figure 2A of Kramer.

Additionally, Kramer teaches that the sprayer is inserted coaxially into the cylinder and rotated around the central axis of the cylinder while being moved axially (column 3, lines 44-66). One of ordinary skill would recognize that in order to perform the process suggested above (using laser spraying as the thermal spraying means), the

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laser must follow the same path. This results in the configuration of claims 1, 13, and 15.

As to claims 8-12, the depth of alloying and thickness of deposition is not explicitly taught by Kramer. However, to use a depth and thickness that provides adequate protection, while still providing clearance for the piston to fit in the cylinder, would have been obvious. To determine the process parameters such as number of passes, laser power, and speed of pass would have been within the skill of one practicing in the art through routine experimentation in order to achieve a sufficient thickness.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer et al. (US 5,080,056) in view of Sailer et al. (US 5,644,828) and Hammeke (US 4,724,299), as applied to claim 1 above, and further in view of Pfeffinger et al. (US 6,221,504 B1).

The above-cited references are used for teaching the limitations of claim 1, but they fail to teach using an additional laser treatment in order to deposit oil pockets. However, Pfeffinger teaches that additional laser treatments may be used to deposit lubricants into the interior walls of cylinder bores in order to increase the tribological characteristics of the coating (column 3, lines 35-40; abstract). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to use additional laser treatments in Kramer in order to deposit oil pockets such that the tribological characteristics of the coating/alloy is increased.

Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer et al. (US 5,080,056) in view of Sailer et al. (US 5,644,828) and Hammeke (US 4,724,299), as applied to claims 13 and 15 above, and further in view of Beyer et al. (US 6,197,386 B1).

The above-cited references are used for teaching the limitations of claims 13 and 15, but they fail to teach the use of mirrors to direct the laser beam to the inner wall of the substrate. However, Beyer teaches the use of a mirror in order to deflect a laser beam such that it hits a desired location on a substrate (figure 1, reference 4). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a mirror to deflect the laser beam. By doing so, the laser beam is directed to the desired location.

### ***Response to Arguments***

Applicant argued that in the previous rejection failed to show a teaching of the powdery material being fed through the laser. From this, it is interpreted that "laser" only refers to the apparatus producing the laser beam. From this interpretation, the examiner agrees with the applicant's argument. The previous rejections have been withdrawn accordingly. The rejections of the current action take into account this limitation as Hemmeke clearly teaches that the powder is being fed through the apparatus that produces the laser beam.

All other arguments are moot in view of the new grounds of rejection.

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**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached at (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



EBF  
May 16, 2003



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